

REMARKS

Applicants respectfully request reconsideration of the present application in view of the following remarks. Prior to this response, claims 1-20 were pending, of which claims 1 and 11 are independent. In the Final Office Action,¹ the Examiner rejected claims 1-20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2005/0114778 ("Branson") in view of U.S. Patent No. 5,995,101 ("Clark") and further in view of U.S. Patent Publication No. 2003/0229608 ("Reynar"). By this response, Applicants have amended independent claims 1 and 11. Support for these amendments may be found in the specification at, for example, ¶ [063]. No new matter has been added. Applicants respectfully traverse the foregoing rejection for at least the following reasons.

Applicants request reconsideration and withdrawal of the rejection of claims 1-20 under 35 U.S.C. § 103(a) over *Branson* in view of *Clark* and further in view of *Reynar*. The Examiner has not properly resolved the *Graham* factual inquiries, the proper resolution of which is the requirement for establishing a framework for an objective obviousness analysis. See M.P.E.P. § 2141(II), citing to *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), as reiterated by the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 U.S.P.Q.2d 1385 (2007).

While Applicants have amended independent claims 1 and 11 to further demonstrate the differences between *Reynar* and the claims, Applicants maintain that the Examiner has not properly ascertained the differences between the claims and the

¹ The Office Action contains statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

references, at least because he has not interpreted the references and considered both the claims and the prior art as a whole. See M.P.E.P. § 2141(II)(B).

Independent claim 1 has been amended to recite, among other things, “automatically providing, without querying the user, a second portion of the structured database information and the options relating to the event through an enterprise solution portal that accesses the second portion of the structured database information in a remote enterprise database when the application local to the user’s computer is determined as being insufficient to address the second request for additional structured database information and to provide the options relating to the event, wherein the user is provided with a smooth transition between the application local to the user’s computer and the enterprise solution portal, the second portion is larger than the first portion, and the options include a mechanism for making the decision.” Independent claim 11, while different in scope, has been amended in a similar manner as independent claim 1. Applicants respectfully submit that none of *Branson*, *Clark*, or *Reynar*, either alone or in combination, teaches or suggests at least these features of Applicants’ amended independent claims 1 and 11.

In rejecting independent claims 1 and 11, the Examiner conceded that neither *Branson* nor *Clark* explicitly discloses the above-referenced feature. See Office Action, pp. 4-5. However, the Examiner contended that *Reynar*, in its paragraphs [0091], [0093] and [0094], discloses the above feature and that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine *Bronson* with *Clark* and *Reynar* to arrive at the subject matter of claims 1 and 11.

Contrary to the Examiner's contention, Applicants submit that *Reynar* also fails to show or suggest at least "automatically providing, without querying the user, a second portion of the structured database information and the options relating to the event through an enterprise solution portal that accesses the second portion of the structured database information in a remote enterprise database when the application local to the user's computer is determined as being insufficient to address the second request for additional structured database information and to provide the options relating to the event, wherein the user is provided with a smooth transition between the application local to the user's computer and the enterprise solution portal, the second portion is larger than the first portion, and the options include a mechanism for making the decision," as required by independent claims 1 and 11.

Reynar generally discloses "[a] method and system . . . provid[ing] for creation, implementation and use of computer-generated 'smart' documents to which functionality is attached for providing contextually sensitive tools, controls and help content to users of those documents." *Reynar*, Abstract. To this end, *Reynar*, in its cited paragraphs [0091], [0093] and [0094], discloses that in order for a user to access a smart document to which such functionality is attached, "a determination is made as to whether the user would like to download the solution. . . .[T]he user may be 'prompted' by the application 100 and informed that the document 110 will work more efficiently, or will be more useful, if the user downloads certain help and action functionality to the user's document." *Reynar*, ¶ [0093]; see also *id.* at ¶ [0094] (noting that "[i]f the user desires to download the solution(s)" then "components necessary for providing the

desired solution(s) to the document 110 are downloaded to the user's computer from some remote source.").

In other words, in *Reynar* "[a] number of queries [are] . . . made to the user to ask the user whether the user would like . . . the desired solution to be downloaded," *Reynar*, ¶ [0093], as opposed to "automatically providing, without querying the user, a second portion of the structured database information and the options relating to the event through an enterprise solution portal," as required by independent claims 1 and 11. Moreover, because *Reynar* requires the user to be queried prior to downloading help and action functionality to the user's document, it also does not teach or suggest that "the user is provided with a smooth transition between the application local to the user's computer and the enterprise solution portal," as required by independent claims 1 and 11. Accordingly, Applicants submit that *Reynar* fails to teach or suggest "automatically providing, without querying the user, a second portion of the structured database information and the options relating to the event through an enterprise solution portal that accesses the second portion of the structured database information in a remote enterprise database when the application local to the user's computer is determined as being insufficient to address the second request for additional structured database information and to provide the options relating to the event, wherein the user is provided with a smooth transition between the application local to the user's computer and the enterprise solution portal, the second portion is larger than the first portion, and the options include a mechanism for making the decision," as required by independent claims 1 and 11.

As set forth above, neither *Branson*, *Clark*, nor *Reynar* teach or suggest every feature of Applicants' amended independent claims 1 and 11. Consequently, the Final Office Action has not properly ascertained the differences between the references and the rejected claims. Accordingly, no reason has been clearly articulated as to why the claims would have been obvious to one of ordinary skill in the art. For at least this reason, claims 1 and 11 should be allowable.

Claims 2-10, 11-20 depend from one of allowable independent claims 1 and 11 should be allowable at least due to their dependence from base claim 1 or 11. Therefore, for at least these reasons, the Examiner should withdraw the 35 U.S.C. § 103(a) rejection of claims 1-20.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-20 in condition for allowance. Applicants submit that the proposed amendments of claims 1-20 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 22, 2008

By:



Cathy C. Ding

Reg. No. 52,820